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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,608	06/21/2000	Valeria Palestini	3572-18	7300

7590

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EXAMINER

HESS, DANIEL A

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/598,608

Applicant(s)

PALESTINI ET AL.

Examiner

Daniel A Hess

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38 is/are allowed.
- 6) ☒ Claim(s) 1-17, 26-33 and 37 is/are rejected.
- 7) ☒ Claim(s) 18-25 and 34-36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 9
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### Interview Summary

Application No.

09/598,608

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PALESTINI ET AL.

Examiner

Daniel A Hess

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All participants (applicant, applicant's representative, PTO personnel):

(1) Daniel A Hess.

(3)\_\_\_\_\_.

(2) Mr. William Burnam.

(4)\_\_\_\_\_.

Date of Interview: About 12/17/02 .

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: \_\_\_\_\_ .

Claim(s) discussed: All .

Identification of prior art discussed: See Continuation Sheet .

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Possible allowable subject matter, including the projecting of specific information (rather than just success/fail) at the code, was discussed. Applicant wanted to receive a full action however, rather than cancel particular claims .

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview(if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

\_\_\_\_\_  
Examiner's signature, if required

Continuation of Identification of prior art discussed: A Welch-Allyn scanner, used at the workstations of patent examiners at the USPTO, has the feature that it continuously flashes a beam back and forth across the barcode, attempting the scan. At the moment a barcode is successfully read, the scanning beam turns off, which conveys to the user that the barcode has in fact been successfully read. If and only if the barcode has been read, processed by a decoder, and successfully converted into the characters it represents, the scanning beam will be cut off. .

### **DETAILED ACTION**

1. This is in response to amendment received November 15, 2002, which has been placed in the file of record.

#### ***Remarks***

2. Because some grounds of rejection are new, this action is made non-final. The applicant has overcome the Suzuki reference of the previous action. In essence, that reference is being replaced with a discussion of a scanner which behaves similarly that is in use at the PTO.

#### ***Claim Rejections - 35 USC § 112***

3. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 does not make sense because communicating the code to a remote processing unit implies that the code has *already* been read.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1,3-8, 26-28, 32, 33 and 37 rejected under 35 U.S.C. 102(b) as being anticipated by the Welch-Allyn Scanteam 3400 Series scanner (ScanTeam 3400 Series product literature, 1998).

The ScanTeam 3400 shows an optical reader having all of the elements and means as discussed in claims 1, 3-8, 26-28, 32, 33 and 37 drawn to the apparatus and claim 18, drawn to the method. *In discussing these claims the examiner wishes to point out that the applicant clearly states (page 1, lines 20-22) that the phrase 'indication of the reading result' means either (i) mere indication of the end of the reading or (ii) of an unsuccessful attempt. For the sake of examination, the examiner will use the first definition, as it is more broad.*

Re claims 1, 26, 27, 32, 33 and 37: Official Notice is taken that the Welch-Allyn ScanTeam 3400 Series scanner, used at the workstations of patent examiners at the USPTO at least since 1998, has the feature that it continuously flashes a beam back and forth across the barcode, attempting the scan. At the moment a barcode is successfully read, the scanning beam turns off, which conveys to the user that the barcode has in fact been successfully read. If and only if the barcode has been read, processed by a decoder, and successfully converted into the characters it represents, the scanning beam will be cut off. The turning off the scanning beam as soon as light is conveyed is in effect result indication.

Re claims 3 and 4: A switch is implied if the light go to turn on and off.

Re claims 5, 6 and 28: Diffractive elements, diaphragms with a predetermined shape, slides, reflecting surfaces with a predetermined shape/shutter, and diffractive elements and holograms are all alternative and equivalent ways of controlling the light source. However they

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are equivalent to a switch when the purpose is merely to indicate the completion of a read operation. The principle of equivalence is discussed in *in re Dillon* (919 F.2d at 692, 16 USPQ2d at 1900).

Re claim 7: A light source must by necessity be present to project light onto the barcode.

Re claim 8: With the ScanTeam 3400 Series scanners, the scanning beam also acts as an indicator of scanning success, as discussed above.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 12-14 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over the ScanTeam 3400.

Re claims 12, 13, 14 and 30: Although a converging lens is not explicitly shown in ScanTeam 3400, the examiner takes Official Notice that the use of lenses and other means in optical code scanners is notoriously old and well known in the art. Their inclusion at the time of the invention would have been obvious to improving scanning resolution and sensitivity.

8. Claims 9, 15-17 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over ScanTeam 3400 in further view of Bard et al. (US 5,856,660).

Re claims 9 and 29: Bard (column 3, lines 42-44) discusses the use in prior art of a green light to indicate a successful scan.

In view of Bard's teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known colored light indication of Bard into ScanTeam 3400 because users are familiar (from driving, etc.) with the concept of moving on in response to certain colors (green) and stopping to check conditions in response to other colors (red).

Re claims 15-17 and 31: As Bard notes (column 3, lines 42 – 43) it is common in the art to use a light flashed at the operator to indicate a successful read, or alternatively or in combination, there may be a beep.

In view of the prior art mentioned by Bard, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known light and/beep directed at the operator of a barcode scanner into the inventive apparatus of Bard because these means ensure that an immediate result of the scan will be conveyed to the user



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through the sense of sight in the form of a flash of light, and in through the sense of sound in the form of a beep. These signals are hard to miss.

9. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over ScanTeam 3400 in further view of Foster (US 5,587,704).

Re claim 10: ScanTeam 3400 fails to show a flashing light mechanism, in other words, a mechanism that modulates the intensity of a light or turns it on or off.

Foster shows a flashing light which works to grab the attention of individuals who see it, in a manner that is very hard to miss (see abstract).

In view of Foster, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known flashing light and light of modulating intensity shown by Foster in the teachings of ScanTeam 3400 because as Foster illustrates, this is a great attention-grabber. It would thus have been a good way to provide important information to the operator of a barcode scanner.

#### ***Allowable Subject Matter***

10. Claims 18-25, 34, 35 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The ScanTeam 3400 does not discriminate between different types of read outcomes, only between reads that have completed and reads that have not completed. Claim 19 refers to discriminating between at least two possible outcomes. Claims 20-23, 34, 35 and 36 refer to a

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negative result, but again, ScanTeam 3400 does not have a negative result, only an absence of reading completion. For that matter, there isn't an indication of whether the code that has been read is a valid code that corresponds with a particular product in the store. Re claims 24 and 25, ScanTeam 3400 gives no motivation for a second luminous information.

In addition, there is no indication in the prior art of record of any particular product information being projected at the barcode.

Claim 38 is allowed for the same reasons as discussed above.

### ***Response to Arguments***

11. Applicant's arguments with respect to claim 1-36 have been considered but are moot in view of the new ground(s) of rejection. The examiner agrees that, as the applicant points out, the light source 17 is turned back on prior to the decoding portion of the read operation.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

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14. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



DH

December 31, 2002

Daniel A Hess  
Examiner  
Art Unit 2876



KARL D. FRECH  
PRIMARY EXAMINER